

REMARKS/ARGUMENTS

Claims 1-9, 18, 20-22, 24 and 26 are now pending in this application. Claims 10-17, 19, 23 and 25 have been cancelled. Claims 1, 18 and 22 are independent claims. Claims 1, 18, 22 and 24 have been amended.

Claim Rejections – 35 USC § 102(b)

Claims 18, 20-24 and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Heil et al., United States Patent Number: 6,173,374 (hereinafter: Heil). (Final Office Action, Page 2). Applicants respectfully traverse these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claims 1, 18 and 22 each generally recite elements that have not been disclosed, taught or suggested by Heil. For example, Claims 1, 18 and 22 generally recite: “the bus interface message request being a Fusion Message Passing Technology (MPT) request.” The Patent Office correctly acknowledges that Heil does not teach the above-referenced elements of the claimed invention. (Final Office Action, Page 5). Further Claims 18 and 22 each generally recite the Fusion MPT request as including: “an address, a command and data in SCSI format”. (Present Application, Page 5, Paragraph 0013). Nowhere in Heil are the above-reference terms disclosed, taught or suggested. Therefore, under *Lindemann*, a prima facie case of anticipation has not been established for claims 1, 18 and 22. Thus, independent claims 1, 18 and 22 should be allowed. Further, dependent claims 2-9 (which depend on independent claim 1) dependent claims 20 and 21 (which depend on independent claim 18) and dependent claims 24 and 26 (which depend on independent claim 22) should also be allowed.

Claim Rejections – 35 USC § 103(a)

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of LSI Logic's Fusion-MPT. (Final Office Action, Page 5). Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of LSI Logic's Fusion-MPT. (Final Office Action, Pages 5-6). Claims 1-4 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex HBAnyware. (Final Office Action, Page 7). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex HBAnyware. (Final Office Action, Page 10). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex HBAnyware. (Final Office Action, Page 10). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex HBAnyware. (Final Office Action, Page 11). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Heil, in view of Emulex HBAnyware, in further view of LSI Logic's Fusion-MPT. (Final Office Action, Page 11). Applicants respectfully traverse these rejections.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (emphasis added). Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). “If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious.” (emphasis added) *In re Fine*, 837 F. 2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988). Applicants respectfully submit that the claims rejected under this section include elements that do not appear to have been disclosed by any of the references cited by the Patent Office, either alone or in combination.

It is contended that Independent Claims 1, 18 and 22 are non-anticipatory and non-obvious based on the rationale above, therefore Independent Claims 1, 18 and 22 should be allowed. Thus, Dependent Claims 2-9 (which depend on Independent Claim 1), Dependent Claims 20 and 21 (which depend on Independent Claim 18) and

Dependent Claims 24 and 26 (which depend on Independent Claim 22) should also be allowed. Dependent Claims 19 and 25 have been cancelled.

Further, there would have been no motivation for one of ordinary skill in the art at the time of the present invention to look to Heil or implement Heil with either Emulex HBAnyware or LSI's Fusion-MPT technology to arrive at the present invention. The present invention focuses on configuration and updating of remote HBAs, (Present Application, Page 2, Paragraph 0002) while Heil proposes a method of intercommunication between clustered I/O nodes. (Heil, Abstract). Therefore, it would not have been obvious for one of ordinary skill in the art at the time of the present invention to look to, modify or combine Heil with the other cited references to arrive at the claimed invention.

Based on the above rationale, there would have been no motivation for one of ordinary skill at the time of the present invention to combine the above-cited references.

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

The Patent Office has proceeded to *impermissibly* use the present patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention and, in light of the current amendments, has failed to make a *prima facie* case of obviousness against claims 1, 18, and 22. Thus, claims 1, 18, and 22 should be allowed over the prior art of record. Claims 2-9 (which depend from claim 1), Claims 20 and 21 (which depend from claim 18), and claims 24 and 26 (which depend from claim 22) should also be allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.

Respectfully submitted on behalf of

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